



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/160,916	09/25/98	WOOLFORD	M 3616.20USC3

PM92/0719
MERCHANT GOULD SMITH EDELL & SCHMIDT
1000 NORWEST CENTER
ST. PAUL MN 55101

EXAMINER

TAYLOR, D

ART UNIT	PAPER NUMBER
----------	--------------

3672

DATE MAILED: 07/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/160,916Applicant(s)
Woolford, M. et alExaminer
Dennis L. TaylorGroup Art Unit
3672☒ Responsive to communication(s) filed on Jun 7, 1999☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 30-102 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 30-102 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3672

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it does not properly reflect a disclosure of the invention as now being claimed. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 59-65 are rejected under 35 U.S.C. § 101 because they improperly embrace both product or machine and process. The language of 35 U.S.C. § 101 sets forth statutory classes of invention in alternative only. See *Ex parte Lyell*, 17 USPQ2d 1549.

35 U.S.C. § 112, second paragraph states:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

Claims 59-65 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 59-65 are ambiguously constructed and indeterminate in scope because they purport to claim both an apparatus and method of using or practicing the apparatus in a single claim.

Art Unit: 3672

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-58 and 67-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Keystone brochure entitled "Beautiful Do-It Yourself Results", cited by Applicants in an Information Disclosure Statement filed June 6, 1999. The brochure, according to Applicants has a June 27, 1988 date. With respect to claim 30, first, it appears that a comma (,) should be placed at the end of line 7 and after "less" in line 11. With respect to claims 30, 37 and 73, the brochure shows or teaches the structure recited in these claims except for the lower planar surface having a smaller area than the upper planar surface. However, this limitation is not considered to be a patentable distinction because there is nothing recited in the claim that would indicate that a difference in the areas provides any new or unobvious results or is any more than a matter of design choice obvious to one skilled in the art. As to claims 31-37, 38-58, 68-72, 74-79, 81-83, 85-93, 95-97 and 99-102, these claims are directed to structure which is old and well known in the art, for example, as shown by the brochure, and/ or which is considered to be no more than a matter of design choice and therefore such structure is not considered to constitute patentable distinctions.

5.

Art Unit: 3672

DOUBLE PATENTING REJECTION(S)

Claims 30-58 and 67-102 are considered to be rejectable over the claimed disclosure of patent No. 5,827,015 of which this is a continuation, on the basis of judicially-created non-statutory double patenting. See *In Re Schneller*, 397, F.2d. 350; 158 USPQ 210 (CCPA 1968).

A perusal of the instant claims clearly indicates that the subject matter thereof is fully disclosed by the claims of said patent and/or that portion of the patent disclosure which provides support for such claims. See *In Re Vogel*, 422 F.2d. 438; 164 USPQ 619 (CCPA 1970). Therefore, it is axiomatic that the instant claims are nothing more than an obvious variation of the inventions(s) disclosed and claimed in said patent and cannot properly issue in the absence of a terminal disclaimer. Furthermore, it is also clear that the inventions could have included the instant claims in said patent and that if the instant application were to issue without a terminal disclaimer, protection of the previously patented inventions(s) would be improperly extended until the expiration of the instant claims since the utilization of such inventions(s) would infringe the instant claims.

An art rejection has not been made on the claims at this time on claims 59-66 in view of the *In re Steele, Mills, and Leis* decision, 134 USPQ 292 which states:

Considerable speculation as to meaning of terms employed and assumptions as to scope of claims were made by examiner and Board; they were wrong in relying on speculative assumptions as basis for rejection under 35 U.S.C. 103; court is in a quandary as to what is covered by claims; substantial confusion as to interpretation of claims arose and has continued


Art Unit: 3672

because claims do not particularly point out and distinctly claim invention as required by 35 U.S.C. 112; rejection is reversed because it is based on unsupported speculative assumptions; this is not to be construed as meaning that court considers claims to be patentable as presently drawn; claims should be reviewed to insure compliance with 35 U.S.C. 112.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Taylor whose **telephone number is (703) 308-1013**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell, can be reached on (703) 308-2151. The **fax phone number for this Group is (703) 305-3597**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


DENNIS L. TAYLOR
PRIMARY EXAMINER
ART UNIT 3672

July 19, 1999
(13) 160916.2nd